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FC-10 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: Jackson et al. Examiner: WILKINS III., H.D.
Serial No.: 10/601,602 Group Art Unit: 1742
Filing Date: June 23, 2003
For: Low Energy Chlorate Electrolytic Cell and Process

REQUEST UNDER 37 CFR 1.143 FOR
RECONSIDERATION OF REQUIREMENT FOR
RESTRICTION AND ELECTION OF SPECIES

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Official Action mailed on September 20, 2005, having a shortened statutory period for reply set to expire on October 20, 2005, please reconsider and withdraw the requirement for (1) election and restriction and (2) election of species, which are the only points raised in the Official Action, for the following reasons:

In order to provide a complete response, the Applicants hereby provisionally elect, for prosecution in this application on the merits, the invention of Group II, drawn to an electrolytic cell, (Claims 8-29) and, as the provisionally elected species, the invention of claim 8, with claims 9-17 readable thereon, but traverses the requirement for restriction with respect to the invention of Groups I and III.

1. The Examiner states on page 2, paragraph 2, of the Official Action that (1) the inventions of Groups II and I(a) are distinct and related as combination and subcombination, (2) that the combination (the electrolytic cell of claim 8) does not require a specific alkali metal ion transport efficiency, and (3) that the subcombination can be used, for example, in a chlor-alkali electrolytic cell. It is respectfully submitted that these inventions are not properly related as combination and subcombination and that, in any case, (2) is not decisive as showing distinctness when the example of (3) is not workable, as further described below.

It is respectfully submitted that the Examiner has not shown the invention of Claims 1-7 and 30-31 (Group I) to be distinct from the invention of claims 8-29

(Group II), as required under rules of The Manual of Patent Examining Procedure (MPEP), Section 806.05 (h). These inventions are more properly considered to be related as *product and process of use of the product* rather than as combination and subcombination, as the Examiner has stated on page 2, paragraph 2, of the Official Action. In addition, it is considered that the burden upon the Examiner to suggest a workable example of an alternate use of the product or process has not been met, as described below. Reconsideration and withdrawal of this requirement are respectfully requested.

2. The Examiner also states on page 2, paragraph 3, of the Official Action that the inventions of Groups III (claims 32-33) and I are related as combination and subcombination and that said combination (the invention of claims 32-33) is not required to have a specific alkali metal ion transport efficiency. It is respectfully submitted that the Examiner has confused claims 32-33, drawn to the use of a hydrophilic diaphragm in an electrolytic cell with claims 30-31, drawn to an electrolytic cell utilizing a low alkali metal ion transport efficiency permselective

membrane. Accordingly, the membrane of claims 1-7 is not recited in claims 32-33 and, thus, is not properly a subcombination of claims 32-33. As stated above, the alternate use example of the permselective membrane recited in Group I, claims 1-7, in a chlor-alkali cell, as suggested by the Examiner, is considered irrelevant as well as not workable, as described below, utilizing said membrane. Reconsideration and withdrawal of this requirement are respectfully requested.

3. The Examiner states on page 3, paragraph 4, of the Official Action that the invention of the claims of Groups III and II and Groups I(b) and II are related as process and apparatus for its practice. The invention of Group III, claims 32-33, relate to the use of a diaphragm in an electrolytic cell; the invention of Group I, claims 30-31, relate to the use of a permselective membrane in an electrolytic cell; and the invention of Group III, claims 32-33, relate to the use of a diaphragm in an electrolytic cell.

The alternative example suggested by the Examiner of the use of the product (of claims 1-7) in a chlor-alkali cell, is considered not workable because in the chlor-

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alkali electrolytic cell process, a permselective membrane separating the anolyte and the catholyte compartments of the electrolytic cell is known to be required to have high transport efficiency for alkali metal ions, not the low transport efficiency of the permselective membrane as recited in the Applicants' claims. Reconsideration and withdrawal of this requirement are respectfully requested.

In any event, with the foregoing election of claims and species for prosecution, the Applicants' claims 8-29 and species claim 8, claims 9-17 readable thereon, are in condition for action on the merits.

Respectfully submitted,

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I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 1, 2005.

Person mailing: A. Pierce Signature: Andrew Pierce Date: Oct 1, 2005